AMENDMENTS TO THE DRAWINGS

The attached four sheets of drawings include changes to FIGS. 9, 10, 13 and 14. Applicants' specification refers to "connector 107" in the description of both FIG. 9 and FIG. 10. However, reference number "107" was inadvertently omitted from FIGS. 9 and 10. The attached sheets include new versions of FIGS. 9 and 10 incorporating the omitted reference number "107." In addition, Applicants' specification refers to "connector 113" in the description of both FIG. 13 and FIG. 14. However, reference number "113" was inadvertently omitted from FIGS. 13 and 14. The attached sheets include new versions of FIGS. 9 and 10 incorporating the omitted reference number "107," and new versions of FIGS. 13 and 14 incorporating the omitted reference number "113."

Attachment: Replacement Sheets (4)

REMARKS

This Amendment is responsive to the Office Action dated August 4, 2005. Applicants have amended claim 5. Claims 1-32 are pending.

Claim Objections

In the Office Action, the Examiner objected to claim 5 because "neurostimulator" was misspelled. Applicants have amended claim 5 to correct the misspelling. Applicants respectfully request withdrawal of the objection.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-5, 8, 12-16, 22-26, 28-30 and 32 under 35 U.S.C. 102(a) as being anticipated by Lebel et al.(US 2003/0065308). Applicants respectfully traverse the rejection. Lebel et al. (Lebel) fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(a), and provides no teaching that would have suggested the desirability of modification to include such features.

For example, Lebel fails to teach or suggest activating telemetry circuitry in a programmer for a medical device, and disabling a display in the programmer during activation of the telemetry circuitry to reduce electrical interference, as recited by Applicants' claim 1. Instead, paragraphs [0257] and [0258] of Lebel describe an Electroluminescent (EL) backlight panel used to illuminate the LCD in low light level conditions. Lebel describes a high RF quiet signal that enables the selection of the backlight, and a low RF quiet signal that disables the selection of the backlight.

Lebel does not disclose or suggest disabling a *display* during activation of telemetry circuitry. The backlight described in the Lebel reference is not the display. Instead, the backlight illuminates the display to improve visibility of the display in low light conditions. Lebel fails to teach disabling the display during activation of telemetry circuitry. Lebel also fails to provide any teaching that would have suggested the desirability of disabling the display, or any component other than the backlight.

For at least the reasons stated above, Lebel also fails to describe disabling the display during telemetry, as recited by Applicants' independent claims 12, 28 and 32. Furthermore,

Lebel does not disclose disabling the display during communication via the telemetry circuitry, as recited by Applicants' independent claims 24.

Similarly, Lebel does not teach or suggest the features of Applicants' dependent claims 2-11, 13-23, 25-27 and 29-31. For example, claims 4, 5, 15, 16, 26 and 30 recite enabling the display when telemetry circuitry is not activated. With respect to this feature, the Examiner again referred to paragraph [0257] of Lebel, which discloses a high RF quiet signal that enables the selection of the backlight, and a low RF quiet signal that disables the selection of the backlight. Lebel makes no mention of enabling the *display* when telemetry circuitry is not activated. The backlight is not the display, but merely illuminates the display to improve visibility of the display in low light conditions. Lebel fails to teach the display itself being enabled when the telemetry circuitry is activated.

The Examiner noted that "enabling" was interpreted as lighting the backlight of Lebel, while "disabling" was interpreted as turning off the backlight. However, this interpretation is inconsistent with the actual requirements of Applicants' claims, which require enabling a display, and not a backlight associated with a display. Applicants note that a display may be enabled even when a backlight is not enabled. As mentioned above, a backlight merely serves to improve visibility of the display. The state of the backlight does not control the operation of the display. On the contrary, in ordinary lighting conditions, a display can be readily viewed without activation of a backlight.

In order to support an anticipation rejection under 35 U.S.C. 102(a), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."[1] If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(a) is improper. [2]

Lebel fails to disclose each and every limitation set forth in claims 1-5, 8, 12-16, 22-26, 28-30 and 32. For at least these reasons, the Examiner has failed to establish a prima facie case

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[1] *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").
[2] *Id. See also Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

for anticipation of Applicants' claims 1-5, 8, 12-16, 22-26, 28-30 and 32 under 35 U.S.C. 102(a). Withdrawal of this rejection is requested.

Claim Rejection Under 35 U.S.C. § 103

Claims 6, 7, 9, 11, 17, 18, 20, 21, 27, and 31

The Examiner rejected claims 6, 7, 9, 11, 17, 18, 20, 21, 27 and 31 under 35 U.S.C. 103(a) as being unpatentable over Lebel in view of Stanton et al. (US 6,249,703). Applicants respectfully traverse the rejection. The applied references fail to disclose or suggest the inventions defined by Applicants' claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

The Examiner correctly acknowledged that Lebel fails to teach providing an internal and external antenna wherein the display is enabled when the external antenna is in use and disabled when the internal antenna is in use, as recited by Applicants' claims 6, 7, 17, 18, 27 and 31. However, the Examiner cited Stanton et al. (Stanton) as teaching a programmer for an implantable device that comprises an internal antenna and a removable external antenna. The Examiner also stated that it is well known to those with ordinary skill in the art that the electromagnetic interference emitted from an LCD display is negligible at distances larger than a few millimeters. On this basis, the Examiner concluded that it would be obvious to disable a display when using the internal antenna and enable a display when using the external antenna to provide maximum visibility to the user while minimizing electromagnetic interference.

As described above, Lebel fails to teach disabling a *display* during telemetry, as recited by independent claims 1, 12, 24, 28 and 32. Stanton provides no teaching capable of overcoming the deficiencies of Lebel. In addition, Stanton does not teach or suggest disabling a display when using an internal antenna and enabling the display when using an external antenna. In fact, Stanton fails to even disclose a display in the programmer.

The Stanton reference makes no correlation between the type of antenna being used and whether another component of the programmer is enabled or disabled, much less enablement of a display when using an external antenna. The cited references provide no motivation to modify

the communication device of Lebel to disable the display when using an internal antenna or enable the display when using an external antenna.

It is well established that the Examiner bears the burden of establishing a prima facie case of obviousness.[3] In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention.[4] A prima facie case of obviousness is established only when this burden is met.

The references do not establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicants' invention as claimed. Instead, the conclusion of obviousness advanced by the Examiner relies on a motivation seemingly pulled directly from Applicants' own disclosure, rather than the prior art. Indeed, the Examiner cited no prior art as the source for teaching the motivation to modify the communication device of Lebel to include an internal antenna and an external antenna, as taught by Stanton, such that the display within the communication device is disabled when using the internal antenna and enabled with using the external antenna.

In regard to Applicants' claims 9 and 20, the Examiner asserted that Lebel discloses that the communication device can consist of several hybrid circuit boards and a number of modules to fit the particular design constraints. The Examiner stated that it would have been obvious to one of ordinary skill in the art to place the telemetry circuitry on a first circuit board and the display circuitry on another.

Lebel does not disclose or suggest the features attributed to it by the Examiner. Merely incorporating additional circuit boards and modules is not all that is required by Applicants' claims. Rather, claims 9 and 20 specify placing an internal antenna and telemetry circuitry on a first circuit board and a display on a second circuit board. Lebel merely refers to the incorporation of one or more hybrid circuit boards and a number of peripheral modules within the communication device, with no regard to the particular structural relationship between such boards and the modules. Therefore, it is unclear how Lebel could have specifically suggested placing the internal antenna and telemetry circuitry on a first circuit board and the display on the

[3] *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).
[4] *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

second circuit board. In fact, Lebel provides no indication of such a configuration, and merely states that such boards may be mounted "within, on, or even in some cases external to a device housing," and fails to even mention where the modules may be placed with respect to the circuit boards.

Claim 10

The Examiner rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Lebel in view of Stanton as applied above, and further in view of Stein et al. (US 2004/0230247). Applicants respectfully traverse the rejection. The applied references fail to disclose or suggest the inventions defined by Applicants' claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

As described above, Lebel and Stanton, either singularly or in combination, fail to teach disabling a display during activation of the telemetry circuitry, as recited by independent claim 1. Stein et al. (Stein) provides no teaching capable of overcoming the deficiencies of Lebel and Stanton. Therefore, claim 10 is allowable for at least the reasons discussed above.

The Examiner further acknowledged that Lebel in view of Stanton fails to teach an internal antenna defining an aperture with a battery bay extending at least partially into the aperture. However, the Examiner asserted that FIG. 9 of Stein et al. (Stein) discloses an internal antenna (66) with a battery bay (86) that extends into an aperture formed by the antenna (66) "to increase the inductance of the antenna and efficiently utilize the housing volume." On this basis, the Examiner concluded that it would have been obvious to modify Lebel, as modified by Stanton, to further include such a feature.

Stein provides no teaching that would have suggested the modification proposed by the Examiner. Stein et al. describes a circuit board 68 carrying a pair of battery contacts 77. Batteries 76 are inserted between the battery contacts 77. A rear opening 86 permits batteries 76 to be replaced by a user. Coil 66 is positioned between circuit board 68 and a case front 60.

Stein fails to disclose or suggest a battery bay extending at least partially into an aperture defined by coil 66. Stein does not discuss the aperture formed by coil 66, nor any structural relationship or distance between a battery bay and the aperture of the coil. Consequently, Stein

does not disclose a battery bay extending at least partially into an antenna aperture, as set forth in claim 10.

Moreover, Stein clearly provides no teaching concerning increasing inductance of the antenna or efficiently utilizing housing space, as suggested by the Examiner. Therefore, even if Stein did provide the structural arrangement alleged by the Examiner, there is no teaching that would have suggested the desirability of modification of the Lebel device, as modified in view of Stanton.

Applicants also do not admit or acquiesce in the legitimacy of the Stein reference as prior art against the claimed invention, and reserve the right to dispute the prior art status of the Stein reference in any future communication. In view of the structural differences between the invention defined by claim 10 and the Stein device, however, Applicants reserve further comment at this time.

For at least the reasons expressed above, the Examiner has failed to establish a prima facie case for non-patentability of Applicants' claims 6, 7, 9-11, 17-18, 20-21, 27 and 31 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed agent to discuss this application.

Date: Nov. 4, 2005

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